

REMARKS

I. Status of Claims

With entry of this amendment, claims 13-15, 20-26, and 30-37 are pending. Claims 7-12, 16-19, and 27-29 have been canceled without prejudice herein. Claims 13, 14, 15, 20, 26, and 34-37 have been amended. Those claim amendments will be discussed in more detail below. However, those amendments are supported in the original application, as filed, and do not add new matter.

II. Claim Rejections

A. Claim Rejections Under 35 U.S.C. § 112

Written Description Rejection

The Examiner has rejected claims 5, 7-15, and 20-37 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Office Action at 2. The Examiner contends that there is no support in the specification for “which definition of ‘n’ are excluded when specific substituents corresponding to the definition of ‘R₁’ and ‘R₂’ are present.” *Id.* at 3. Applicants respectfully traverse this rejection. However, without conceding the propriety of the rejection and in an effort to expedite prosecution, the claims have been amended or canceled herein to remove limitations with respect to “n.” As a consequence, this rejection has been rendered moot and should be withdrawn.

Enablement Rejection

The Examiner has rejected claims 27-29 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Office Action at 3. In support of this rejection the Examiner states that determining whether any particular claimed compound would treat any particular autoimmune or mitochondrial disease would require 1) synthesis of the compound, 2) formulation into a suitable dosage form, and 3) conducting clinical trials with a number of “fundamentally different diseases,” or testing them in a correlative assay. *Id.* at 3-4. The Examiner concludes that this is a “large quantity” of experimentation. *Id.* at 4. Applicants respectfully traverse this rejection. However, without conceding the propriety of the rejection and in an effort to expedite prosecution, claims 27-29 have been canceled without prejudice herein. Accordingly, this rejection is rendered moot.

B. Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected claims 5, 7, 9, 13, and 14 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,042,986 to Kitchens et al. (“Kitchens”). Office Action at 6. Without conceding the propriety of the rejection, and solely to expedite prosecution, Applicants have canceled claims 5, 7, and 9 herein, rendering this rejection moot as to those claims. Further, claims 13 and 14, as amended, now depend on claim 20 and recite certain pharmaceutical preparations. Kitchens does not describe pharmaceutical preparations and as such, claims 13 and 14 are not anticipated by Kitchens.

The Examiner has rejected claims 5, 7, 9-12, and 15 under 35 U.S.C. § 102(b) as allegedly being anticipated by Farina et al., *J. Am. Chem. Soc.* (1985) 107:5100-5104, which discloses *trans*-1,2,3,4-cyclobutanetetracarboxylic acid. *Id.* Without conceding the propriety of the rejection, and solely to expedite prosecution, Applicants have canceled claims 5, 7, and 9-12 herein, rendering this rejection moot as to those claims. Claim 15, as amended, depends on claim 20 and is drawn to certain pharmaceutical preparations. Farina does not describe pharmaceutical preparations and as such, does not anticipate claim 15.

The Examiner has rejected claims 5, 7, and 8 under 35 U.S.C. § 102(b) as allegedly being anticipated by Doerheofer et al., *Tetrahedron Lett.* (1966) 37:4511-4516, which discloses 2,4-dicarbamoylcyclobutane-1,3-dicarboxylic acid. *Id.* at 7. Without conceding the propriety of the rejection, and solely to expedite prosecution, Applicants have canceled claims 5, 7, and 8 herein, rendering this rejection moot.

VII. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 13-15, 20-26, and 30-37 in condition for allowance. Applicants submit that the proposed amendments of claims 13, 14, 15, 20, 26, and 34-37 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.


In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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